

U.S. Serial No. 10/648,350
Response to the Office Action of February 17, 2006

REMARKS

The applicants respectfully traverse the restriction requirement. In view of the following remarks, reconsideration of the application and withdrawal of the restriction requirement is requested.

As noted by the examiner, M.P.E.P. § 806.05(f) states that “A process of making and a product made by the process can be shown to be distinct inventions if [it] can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process.” While “[a]llegations of different processes or products need not be documented” by the examiner, the examiner must allege a viable alternative process or else “the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.” The examiner has failed to allege a viable alternative process.

In the present restriction, the examiner alleges that the product may be made by another materially different process, such as for example, “providing a bottom liner with an adhesive top layer and securing a first web of material to the adhesive top layer.” The proposed process, however, cannot result in the claimed product. In particular, claims 1 and 8 and paragraphs 15 and 16 of specification recite the product and process to make the product as including a top sheet, an adhesive bottom layer, a bottom liner, adhesive strips and a second web of material. As stated above, the examiner suggests that this product can be created by a proposed materially different process that includes “providing a bottom liner with an adhesive top layer and securing a first web of material to the adhesive top layer.” As best understood, what the examiner proposes is removing the top two layers of the claimed product (the top sheet and adhesive bottom layer) and then rotating the remaining layers 180° (i.e., flipping the remaining product over) to secure the exposed top layer to the web. It is unclear how the proposed process would result in the claimed product that comprises a top

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sheet, an adhesive bottom layer, a bottom liner, adhesive strips and a second web of material. At the very least two entire layers are completely missing in any product that would result from the examiner's proposed process.

Because the examiner proposes a process that includes two less layers than the claimed product and process, the examiner has failed to show that the product as claimed can be made by another viable alternative process. Therefore, the Office action fails to meet the second prong of the test outlined in M.P.E.P. § 806.05(f).

Furthermore, the M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. M.P.E.P. § 803. In this instance, although the examiner argues that the groups of claims identified in the Office action are patentably distinct, the examiner has failed to even allege, let alone demonstrate that a serious burden would be placed on the examiner if election were not required. "If the search and examination of an entire application can be made without a serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." *Id.* (emphasis added).

If there is a serious burden in the present application, it is on the assignee of this application as a result of this restriction requirement. Unless the restriction requirement is withdrawn, the assignee must not only prosecute as many as two separate applications, which multiplies the cost and time of obtaining protection for the inventive subject matter, but it must also then pay maintenance fees for each of the issued patent. It is respectfully submitted that the burden of the expense incurred in order to obtain two different patents and the further expense in maintaining those patent suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

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In sum, the examiner has failed to prove that the inventions are distinct by either showing (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process as required by M.P.E.P § 806.05(f). Moreover, the examiner fails to prove or even address the second required criteria for restriction set forth in M.P.E.P. § 803, i.e., that there be a serious burden on the examiner if restriction is not required. Therefore, for at least this reason alone, restriction is improper. Accordingly, the applicants respectfully request that the restriction requirement be withdrawn and that all pending claims be considered on the merits.

Election under 37 CFR § 1.143

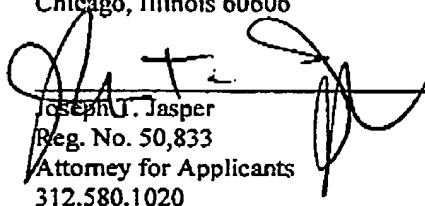
Nevertheless, in order to satisfy the requirements of 37 CFR § 1.143, the applicant provisionally elects to prosecute the product of claims 1-7 and 15-20, *with traverse*.

Conclusion

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,
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